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SACHIKO NISHIURA

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EXAMINER

YANG, RYAN R

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SACHIKO NISHIURA

Appeal 2008-0179
Application 09/454,755
Technology Center 2600

Decided: May 29, 2008

Before ROBERT E. NAPPI, JOHN A. JEFFERY, and CARLA M.
KRIVAK, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

ORDER REMAND TO THE EXAMINER

The present application is remanded to the Examiner under 37 C.F.R. § 41.50 to provide a Supplemental Examiner's Answer specifically addressing Appellant's newly-raised argument on Page 4 of the Reply Brief.

Specifically, the Examiner must address Appellant's contention that the relied-upon passage in the cited Vyncke reference fails to disclose that a new single object is generated. According to Appellant, since the relied-upon passage merely deletes hidden objects (i.e., the square 208 in Figure

8a) and does not generate a new single object, the rejection is ostensibly “based on a misreading of Vyncke and is wrong” (Reply Br. 4).

This is a new argument that is raised for the first time in the Reply Brief. Significantly, Appellant’s arguments in the Appeal Brief were limited to alleging that Vyncke failed to disclose a semi-transparent object. *See* App. Br. 14-16. Notably, the arguments in the Appeal Brief were silent regarding the reference’s alleged failure to disclose generating a new object as now alleged in the Reply Brief.

Since Appellant’s arguments in the Appeal Brief were limited to the semi-transparency issue, the Examiner’s response to these arguments in the Answer was likewise limited to this issue (Ans. 14). In contrast, however, the argument in the Reply Brief is actually silent as to the semi-transparency issue, and is now limited to the newly-raised object generation issue.

It is unclear on the record before us why Appellant chose to present this new argument for the first time in the Reply Brief. Indeed, as our reviewing court has noted, arguments not presented in the opening brief are technically waived.¹ Nevertheless, since resolving this issue is critical in assessing the propriety of the Examiner’s anticipation rejection, the record before us is simply incomplete regarding this newly-raised issue.

Therefore, the present appeal is not yet ripe for decision until the Examiner has had an opportunity to respond to the newly-raised argument in the Reply Brief and the record is more fully developed in this regard. We therefore remand the present application to the Examiner to respond to this

¹ *See Optivus Tech., Inc. v. Ion Beam Applications S.A.*, 469 F.3d 978, 989 (Fed. Cir. 2006) (“[A]n issue not raised by an appellant in its opening brief ... is waived.”) (citations omitted).

argument *specifically explaining how the generating means of Vyncke generates new objects from a semi-transparent source object* as claimed.

If upon reconsideration, the Examiner decides to maintain the rejection, the Examiner must provide a Supplemental Examiner's Answer specifically addressing Appellant's new argument on Page 4 of the Reply Brief. *See* MPEP § 1207.05(II).

The present application on appeal is remanded to the Examiner for appropriate action in accordance with the foregoing instructions.

Because this application has a "special" status, it requires immediate action. *See* MPEP § 708.01(D). The Board must be informed promptly of any action affecting the appeal in this case.

Appeal 2008-0179
Application 09/454,755

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R § 1.136(a)(I)(iv).

REMANDED

tdl/gw

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